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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,869	07/22/2003	Theodore G. Duclos	99-0033(COA) (8470-114COA)	7658
29293 7590 03/25/2008 FREUDENBERG-NOK GENERAL PARTNERSHIP LEGAL DEPARTMENT 47690 EAST ANCHOR COURT PLYMOUTH, MI 48170-2455				
EXAMINER RODRIGUEZ, RUTH C				
ART UNIT 3677		PAPER NUMBER		
NOTIFICATION DATE 03/25/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

fngp@hdp.com
cxc@fngp.com
mlp@fngp.com

Office Action Summary

Application No.

10/624,869

Applicant(s)

DUCLOS ET AL.

Examiner

Ruth C. Rodriguez

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-15,17,19-25 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-15,17,19-25 and 40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 8-11, 14, 17, 19, 21 and 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohn (US 4,776,600).

With respect to claims 1, 10 and 17, Kohn discloses a static gasket (26,29) sealing between first (8) and second (10) sealing surfaces that are secured together. Kohn also discloses a generally flat carrier member (32) having a generally planar top surface, a first stopper member (part of 31 disposed to one side of 27 or 28), second stopper member (part of 31 disposed opposite to the first stopper member and to one side of 27 or 28), a cavity (receiving 27 or 28) formed between the stopper members and the stopper members having a height above the top surface of the carrier member (Figs. 4 and 5). Kohn further discloses an elastomeric seal member (27) inside the cavity (Abstract). The cavity has a volume that is greater than the volume of the elastomeric seal member (Figs. 4 and 5). The elastomeric seal member has at least one sealing bead (Figs. 4 and 5). The sealing bead has an apex that extends from a portion of the top surface (Figs. 4 and 5). Each of the first and second stopper

members has a height above the portion of the top surface from which the apex extends (Figs. 4 and 5). The apex has a height that is greater than the height of the first and second stoppers (Figs. 4 and 5). The apex is adapted to compress to the height of the first and second stoppers as (Figs. 4 and 5). The stoppers prevent the seal member from being over compressed (Figs. 4 and 5). Kohn further discloses a second pair of stoppers on an opposite surface (Figs. 4 and 5). Additionally, Kohn shows a second elastomeric sealing member (27 or 28). The second pair of stoppers limits the compression of the second elastomeric sealing members (Figs. 4 and 5). Kohn shows the first and second stoppers formed independently from the carrier member.

Examiner notes that there are several limitations regarding a method of loading the gasket, or an intended use of the gasket, such as, "A clamp load is applied", and the gasket is "subjected to the clamp load". It is noted that Kohn discloses all of the claimed structural elements, and is capable of being loaded as claimed by applicant. Furthermore, the claims are drawn only to the gasket itself. Kohn meets all of the structural limitations of the gasket.

With respect to claim 2, Kohn discloses the sealing bead to be a semi-round or semi-oval or semi-elliptical (when compressed).

With respect to claims 8, 9, and 21, Kohn discloses the first and second stopper members are made of a material selected from the group consisting of polymer, metal, ceramic and composite fiber board (C. 2, L. 30-40) and the apex is compressed 1.5% to 70%.

With respect to claims 11 and 19, examiner notes these appear to be a product-by-process claim, where a process of making the product is claimed, in a product claim. Claims 11 and 19 are product claims. As such, only the physical structure of the claim is considered. Any prior art reference that meets the structural limitations is considered to be capable of being made in the claimed manner. Examiner asserts that the elastomeric sealing members of Kohn are capable of being formed from any of the claimed cure systems, and the first stopper member is capable of being molded on the carrier.

With respect to claim 14, Kohn's carrier is made of metal (C. 2, L. 30-40).

For claim 40, the carrier member has a thickness and the elastomeric seal has a thickness that is greater than the thickness of the carrier member (Figs. 4 and 5).

For claim 41, each of the first and second stopper members has a height above a portion of the top surface when the gasket is in an unloaded state (Figs. 4 and 5).

Regarding claim 42, the first pair of stopper members have a first height above the first portion when the gasket is in an unloaded state (Figs. 4 and 5).

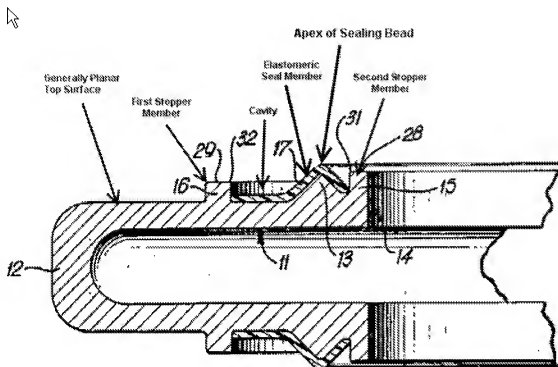
Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

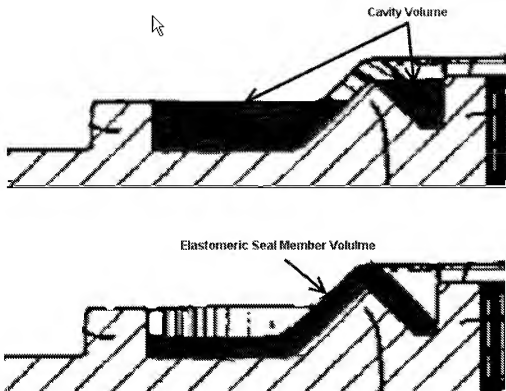
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 7-11, 14, 15, 17-19, 21, 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey (US 3,033,582) in view of Udagawa (US 6,186,513).

With respect to claims 1, 7, 10, 17, 18, 22, and 25, Creavey discloses a static gasket sealing between first (21) and second (20) sealing surfaces that are secured together. Creavey also discloses a generally flat carrier member (11) having a generally planar top surface, a first stopper member (15), second stopper member (16), a cavity formed between the stopper members, and the stopper members having a height above the top surface of the carrier member. The second stopper member (17) has a height greater than that of the first stopper member (16). Creavey further discloses an elastomeric seal member (17) inside the cavity. The cavity has a volume that is greater than the volume of the elastomeric seal member (See figures below). The elastomeric seal member has at least one sealing bead. The sealing bead has an



apex that extends from a portion of the top surface. Each of the first and second stopper members has a height above the portion of the top surface from which the apex extends (Fig. 6). The apex has a height that is greater than the height of the first and second stoppers. The apex is adapted to compress to the height of the first and second stoppers as (shown in figures 3-5), where the stoppers prevent the seal member (17) from being over compressed. Creavey further discloses a second pair of stoppers on an opposite surface (bottom portion of gasket, mirror image stoppers 16, 17), where the stoppers have a height above the opposite surface. Additionally, Creavey shows a second elastomeric sealing member (mirror of 17, bottom portion of gasket in figures 3-5). The second pair of stoppers limits the compression of the second elastomeric sealing members. Creavey shows the first and second stoppers formed integrally, not



independently from the carrier member. However, Udagawa teaches a gasket assembly where a stopper member may be formed either integrally (E12 in figure 6) or independently (F12 in figure 4) from a carrier member (E or F). From this Udagawa shows that stoppers formed integrally and independently of base members are equivalent and interchangeable within the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the stoppers of Creavey either integral or independent from the carrier member, as these are equivalent ways of including stoppers in a gasket arrangement.

Examiner notes that there are several limitations regarding a method of loading the gasket, or an intended use of the gasket, such as, "A clamp load is applied", and the gasket is "subjected to the clamp load". It is noted that Creavey discloses all of the

claimed structural elements, and is capable of being loaded as claimed by applicant. It is further noted that the reactive from the surfaces 20 and 21 of Creavey are identical to the forces that would arise from the clamping forces recited in the claims. Furthermore, the claims are drawn only to the gasket itself. Creavey meets all of the structural limitations of the gasket.

With respect to claims 2-4, Creavey discloses the sealing bead to be a triangle, the volume of the cavity is greater than the volume of the elastomeric seal member, and the elastomeric seal member is formed from a fluorocarbon. U.S. Patent No. 4,460,155 to Smith is cited as an evidentiary reference to show that Teflon (used by Creavey) is a fluorocarbon. Examiner cites Smith column 3, lines 32-34 to show this.

With respect to claims 8, 9, and 21, Creavey discloses the first and second stopper members (16, 17) are metal, and the apex is compressed 1.5% to 70%.

With respect to claims 11 and 19, examiner notes these appear to be a product-by-process claim, where a process of making the product is claimed, in a product claim. Claims 11 and 19 are product claims. As such, only the physical structure of the claim is considered. Any prior art reference that meets the structural limitations is considered to be capable of being made in the claimed manor. Examiner asserts that the elastomeric sealing members of Creavey are capable of being formed from any of the claimed cure systems, and the first stopper member is capable of being molded on the carrier.

With respect to claim 14, Creavey's carrier (11) is made of metal.

With respect to claims 15 and 24, Creavey does not explicitly disclose the stopper members to have a shape factor between .15 and 10. However, since there is no showing of criticality of the recited range, such recited range would have been obvious to one of ordinary skill in the art. Altering the shape factor of an element is considered to a design choice within the skill of the art.

5. Claims 5, 6, 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view of Udagawa, as applied to claims 1, 10, and 17 above, and further in view of Combet et al (US 6,390,479).

The combination of Creavey and Udagawa serves to reject claims 1, 10 and 17 as recited above. Creavey and Udagawa are silent with regard to the dimensions of the carrier member. However, Combet teaches a carrier member having a thickness of less than 1.0 mm and the compressed thickness is in the range of 0.015 and 1.75 mm (column 3, line 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to change the thickness of the prior art carrier since such a modification is a design consideration within the skill of the art. In re Rose, 220 F.2d, 105 USPQ 237 (CCPA 1955).

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view Udagawa, as applied to claim 17 above, and further in view of Lucas et al (US 4,635,949).

The combination of Creavey and Udagawa serves to reject claim 17 as recited above. Creavey and Udagawa fail to disclose an adhesive layer on the second surface of the carrier member. However, Lucas teaches a gasket assembly where a seal ring

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(8) is bonded to the carrier, or sheet, (1) by a heat resistant adhesive. The adhesive positively secures the seal (8) to the carrier (1). It would have been obvious to one having ordinary skill in the art at the time of the invention to positively secure the seal (17) to the carrier member (11) of Creavey. This results in an adhesive layer on the second surface of Creavey.

7. Claims 4, 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohn.

Kohn discloses a static gasket having all the features mentioned above for the rejection of claims 1 and 10. Kohn fails to disclose that the elastomeric seal member is formed of a polymer material selected from the group consisting of fluorocarbon, silicone, fluorosilicone, butyl, ethylene propylene diene monomer, ethylene-acrylate, polyacrylate, isoprene, perfluoropolymer, natural rubber, epichlorohydrin, nitrile, hydrogenated nitrile and thermoplastic elastomer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the elastomeric seal member being formed of a polymer material selected from the group consisting of fluorocarbon, silicone, fluorosilicone, butyl, ethylene propylene diene monomer, ethylene-acrylate, polyacrylate, isoprene, perfluoropolymer, natural rubber, epichlorohydrin, nitrile, hydrogenated nitrile and thermoplastic elastomer since the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

With respect to claims 15 and 24, Kohn does not explicitly disclose the stopper members to have a shape factor between .15 and 10. However, since there is no showing of criticality of the recited range, such recited range would have been obvious to one of ordinary skill in the art. Altering the shape factor of an element is considered to a design choice within the skill of the art.

8. Claims 5, 6, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohn in view of Combet et al (US 6,390,479).

Kohn is silent with regard to the dimensions of the carrier member. However, Combet teaches a carrier member having a thickness of less than 1.0 mm and the compressed thickness is in the range of 0.015 and 1.75 mm (column 3, line 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to change the thickness of the prior art carrier since such a modification is a design consideration within the skill of the art. In re Rose, 220 F.2d, 105 USPQ 237 (CCPA 1955).

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kohn in view of Lucas et al (US 4,635,949).

Kohn fails to disclose an adhesive layer on the second surface of the carrier member. However, Lucas teaches a gasket assembly where a seal ring (8) is bonded to the carrier, or sheet, (1) by a heat resistant adhesive. The adhesive positively secures the seal (8) to the carrier (1). It would have been obvious to one having ordinary skill in the art at the time of the invention to positively secure the seal (17) to

the carrier member (11) of Kohn. This results in an adhesive layer on the second surface of Kohn.

Response to Arguments

10. Applicant's arguments with respect to claim 1, 2, 4-6, 8-11, 13-15, 17, 19-21, 23, 24 and 40-42 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments filed 21 December 2007 have been fully considered but they are not persuasive.

12. The Applicant argues that Creavey fails to disclose "said cavity having a volume that is greater than the volume of said elastomeric seal member" and "said first and second stopper members each having a height above said portion of said top surface from which said apex extends". This argument fails to persuade. The figures used above for the rejection of the claims clearly disclose that the volume of the cavity (darkened area in the upper figure) is greater than the volume of the elastomeric seal member (darkened area in the lower figure). With respect to having "said first and second stopper members each having a height above said portion of said top surface from which said apex extends", figure 6 clearly discloses that the first and second stopper members (upper surfaces 28 and 29) have a height above the portion of the top surface from which the apex extends since the upper surfaces stopper members come in contact with surface 21 while the elastomeric seal member is the contacting the

surface 21 and therefore the surface from which the apex extends is below the stopper members.

13. The Applicant argues once again that Creavey fails to disclose "a generally flat carrier member having a generally planar top surface" since it has the triangular projection. The Examiner fails to agree with this argument because the term "generally" is considered broad term and encompasses other structures that are not flat for the carrier and that are not planar for the top surface. In this case, Creavey discloses a "generally flat carrier" and a "generally planar top surface" when the broadest interpretation is provided to the term "generally" regardless of whether the projection is flat or triangular.

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., cavity formed by the stop members and the carrier that the seal member is disposed in) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims only recite that the first stopper member is formed independently from the carrier member, that the second stopper member is formed independently from the carrier member and that the first and second stopper members form a cavity therebetween. The claims do not require that the cavity must also be formed by a surface of the carrier. The Examiner acknowledges that there can be differences between the stopper disclosed by Udagawa and the stopper being claimed by the current application,

however, these differences are not relevant since Udagawa is only being used for its teaching of two materials for the carrier member since Creavey clearly discloses first and second stopper members that form a cavity therebetween as recited in the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor D. Batson can be reached on (571) 272-6987.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/RCR/
Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr
March 27, 2008

/Robert J. Sandy/
Acting SPE of Art Unit 3677